

## REMARKS

This is intended as a full and complete response to the Final Office Action dated May 14, 2004, having a shortened statutory period for response set to expire on August 14, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-5, 8-22, and 56-69 remain pending in the application after entry of this response. Claims 1, 3-8, 12 and 19-22 are rejected; claims 2, 9-11, 13-18 and 65 are objected to; and claims 56-64 and 66 are indicated to be allowable by the Examiner. Claims 6, 7, and 22 have been cancelled by Applicant without prejudice. Claims 1 and 19 have been amended and new claims 67-69 have been added. No new matter has been added by the amendments or new claim. Allowed claim 2 been re-drafted incorporating original claim 1 as new claim 67. Reconsideration of the rejected claims is requested for reasons presented below.

### Claim Rejections - 35 USC § 102

Claims 1, 3-7, 12 and 19-21 are finally rejected under 35 USC 102(b) as being anticipated by *Diefendorf* (U.S. Patent No. 1,150,178).

Regarding claims 1, 3-5, and 12, Applicant respectfully traverses the rejection. *Diefendorf* does not teach, suggest, or disclose an apparatus, wherein "an opening is provided from an edge to the axial passage of each of the first and second tongs to allow the introduction of the tubular into the axial passage of each of the first and second tongs" as recited in claim 1. *Diefendorf* discloses a two piece clamp (2,3) connected around a pipe by bolts and a two piece worm gear 14 also connected around the pipe by bolts. Since *Diefendorf's* clamp and gear each are bolted around the pipe, he has no need for an opening to receive the pipe into the clamp and gear. Therefore, claim 1 is patentable over *Diefendorf*. Claims 3-5 and 12 are patentable over *Diefendorf* since they depend from claim 1.

Regarding claims 19-21, *Diefendorf* does not teach, suggest, or disclose an apparatus, comprising "a motor coupled to the at least one pinion" as recited in claim

19. Therefore, claim 19 is patentable over *Diefendorf*. Claims 20 and 21 are patentable over *Diefendorf* since they depend from claim 19.

Regarding new claim 68, *Diefendorf* does not teach, suggest, or disclose an apparatus, wherein "a longitudinal axis of the first tong is substantially parallel to a longitudinal axis of the at least one pinion." *Diefendorf* discloses a worm and worm gear configuration. In this configuration, the longitudinal axis of the worm is perpendicular to the longitudinal axis of the worm gear 14. Therefore, claim 68 is patentable over *Diefendorf*.

Regarding new claim 69, *Diefendorf* does not teach, suggest, or disclose an apparatus, wherein "one of the clamping members [is] supported by a frame for handling at an oil rig" as recited in claim 69. *Diefendorf* discloses a clamp and gear that are each supported from a pipe lying in a trench. Therefore, claim 69 is patentable over *Diefendorf*.

#### Claims Rejections - 35 USC § 103

Claims 8 and 22 are finally rejected under 35 USC 103(a) as being unpatentable over *Diefendorf* in view of any of *Smith* (U.S. Patent No. 2,639,894) or *Jurgens* (U.S. Patent No. 4,497,224).

Regarding claim 8, as discussed above, *Diefendorf* does not teach, suggest, or disclose a recess for receiving the tubular into each tong. Neither *Smith* nor *Jurgens* teach, suggest, or disclose a recess for receiving the tubular into each tong. Therefore, claim 1 is patentable over *Diefendorf* in view of *Smith* or *Jurgens*. Claim 8 is also patentable over *Diefendorf* in view of *Smith* or *Jurgens* since it depends from claim 1. Further, claim 8 is patentable on its own merit for reasons similar to those discussed with reference to claim 19, below.

Regarding claims 19-21, as discussed above, *Diefendorf* does not teach, suggest, or disclose a motorized apparatus. *Diefendorf* teaches away from a combination with either *Smith* or *Jurgens* by teaching that the "worm gives sufficient power to set up the pipe with little effort on the part of the workman." Further, a motor would add bulk and weight to an apparatus designed to be moved from fitting to fitting and assembled in a trench. Therefore, claim 19 is patentable over *Diefendorf* in view of

*Smith* or *Jurgens*. Claims 20 and 21 are also patentable over *Diefendorf* in view of *Smith* or *Jurgens* since they depend from claim 1.

Regarding new claim 68, as discussed above, *Diefendorf* does not teach, suggest, or disclose a parallel gear and pinion configuration. *Diefendorf* teaches away from combination with either *Smith* or *Jurgens* by teaching that his apparatus is for use in trenches where the handwheel must extend out of the trench. Further, to modify his invention so the handwheel would be in proper position would require a gearbox which would add bulk and weight to his invention. These are undesirable qualities for a pipe screwing device designed to be assembled in a trench and moved from pipe fitting to pipe fitting. Therefore, claim 68 is patentable over *Diefendorf* in view of *Smith* or *Jurgens*.

Regarding new claim 69, as discussed above, *Diefendorf* does not teach, suggest, or disclose supporting one of the clamping members by a frame. Further, *Diefendorf* teaches away from a combination with either *Smith* or *Jurgens* by teaching that the clamp and the frame are bolted around the pipe and supported therefrom each time a connection is made up for a pipe in a trench. Therefore, claim 69 is patentable over *Diefendorf* in view of *Smith* or *Jurgens*.


### Claims Objections

Claims 2, 9-11, 13-18 and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants believe the amendments to the base claims render the objection moot. Withdrawal of the objection is respectfully requested.

### Conclusion

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the Invention as claimed. Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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William B. Patterson  
Registration No. 34,102  
MOSER, PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicant(s)